

## **REMARKS**

### **Amendments**

Claims 27, 29, and 39 are cancelled. As a result, no pending claims are rejected

### **Information Disclosure Statement**

Applicants acknowledge the consideration by the Examiner of the Information Disclosure Statement of July 1, 2008. However, the Examiner failed to consider the English language abstract of JP 09-227,523. In the Office Action, it is asserted that this document was not considered because "the relevance of the document could not be determined."

Applicants respectfully submit that this assertion is not a proper basis for denying consideration of the document. Submission of the document complies with the requirements of 37 CFR 1.98, and thus must be considered.

Furthermore, the relevance of the document is evident from the prosecution. On June 14, 2006, applicants submitted an Information Disclosure Statement listing the references cited in the International Search Report of the corresponding International application, PCT/EP2004/013202. Included with the Information Disclosure Statement of June 14, 2006 was an English language version of the International Search Report which explained the relevance of the documents cited therein. The Notice of Acceptance issued March 7, 2007 also indicated that the International Search Report had been filed with the USPTO.

In the Office Action of May 21, 2008, the Examiner denied consideration of certain foreign documents cited in the Information Disclosure Statement of June 14, 2006 on grounds that copies were not provided. In response, applicants filed the Information Disclosure Statement of July 1, 2008, which included copies of the cited foreign documents including the English language abstract of JP 09-227,523. See also the discussion of the Information Disclosure Statements at page 20 of the Reply filed June 25, 2008.

In view of the above remarks, applicants respectfully request that the Examiner acknowledge consideration of the English language abstract of JP 09-227,523. Enclosed for the Examiner's convenience is a form PTO/SB/08A listing the document, and a copy of the English language version of the International Search Report.

### **Objection to Claims 30-37**

Claims 30-37 are “objected to as being dependent on a rejected base claim.” This is incorrect.

In the Office Action of October 29, 2008, only Claims 27, 29, and 39 are rejected (these claims are cancelled above). Claim 30 is directly dependent on claim 1, claims 31, 32, 34, and 36 are directly dependent on claim 30, and claims 33, 35, and 37 are directly dependent on claims 31, 33, and 35, respectively.

Withdrawal of the objection to claims 30-37 is respectfully requested.

### **Objection to Claims 1-29, 38, and 39**

The objection is traversed for the reasons of record with respect to the requested Reconsideration of the Restriction. As argued previously, in the Restriction, applicants' compound genus is divided into 11 Groups, depending on the definitions of the variable groups Q, T and the combination of E, Z, and Z'. As noted in the Restriction, **a Markush grouping (as presented in the instant claims) will satisfy PCT rule 13.2 if the alternatives share a common property or activity and there is a significant common structural element shared by the alternatives.**

The compounds share a common activity or property as discussed in applicants' specification. Additional, the alternatives will share a common significant structure, namely a central piperidiny ring, when Z, Z' and E form a piperidine ring. Thus, applicants again respectfully request that groups III, IV, and IX (as well as any relevant compounds within group XI) be examined with the elected Group I as to those compounds in which Z, Z' and E form a piperidine ring.

Applicants are filing herewith a Petition under 37 CFR 1.181 requesting reversal of the Examiner's action in maintaining the Restriction Requirement.

### **Information Disclosure Statement**

The references cited in the Information Disclosure Statement filed June 14, 2006 are the references cited in the International Search Report, a copy of which has been filed with the USPTO (See Notice of Acceptance issued March 7, 2007). The Examiner does not explain why the references from the International Search Report are not being considered in this US national Phase application.

**Rejection of Claims 24 and 27, 29, and 39 under 35 USC 112, first paragraph**

This rejection is traversed for the reasons of record. However, solely for purposes of furthering prosecution, claims 27, 29, and 39 are cancelled,

Thus, no pending claims are rejected.

In view of the above remarks, allowance of the instant application is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Brion P. Heaney/

Brion P. Heaney, Reg. No. 32,542  
Attorney for Applicants

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
Arlington Courthouse Plaza 1  
2200 Clarendon Boulevard, Suite 1400  
Arlington, VA 22201  
Telephone: 703-243-6333  
Facsimile: 703-243-6410  
Attorney Docket No.: MERCK-3185

Date: December 29, 2008